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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/894,373

Applicant(s)

SCHMIDT ET AL.

Examiner

Brian Goddard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 4 and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the user data files" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the examiner ignores the phrase, "the user data files have a variety of formats including", and thus interprets the list of formats for the data files to continue with "Word, Excel, PowerPoint, and Access" after "Lotus Notes".

Claim 14 recites the limitation "the database" in the eleventh line of the claim. There is insufficient antecedent basis for this limitation in the claim. In particular, it is unclear whether "the database" refers to the "first database" (line 7) or the "second database" (line 8).

Claims 15-18 are each dependent upon claim 14, and are therefore indefinite for the same reason as claim 14 above.

In the interest of compact prosecution, the examiner assumes that "the database" refers to the "second database" from line 7, based on the language of the parallel limitation in claim 1.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 6-9 and 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 8-11 and 12-14 (respectively) of copending Application No. 09/944,712 in view of U.S. Patent No. 5,778,395 to Whiting et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application recite only one distinction from the copending claims that would have been an obvious modification to one of ordinary skill in the art.

Referring to claim 1, the copending claim (1) includes all of the limitations of the instant claim except "a data uploading processor, coupled to the file logging processor, for uploading the first database [the database] to a second database." However, the uploading of files from one location to a remote location for archival purposes is common practice in the art, as evidenced by Whiting. In particular, Whiting teaches a

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data uploading processor [100] for uploading [backing up] a first database [102-105] to a second database [101] as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Whiting's data uploading processor for uploading the database to a second database, to the data management system of copending claim 1, in order to obtain the invention as claimed. One would have been motivated to do so in the interest of preserving data integrity through archiving, as evidenced by Whiting.

Referring to claim 3, copending claim 3 includes all of the limitations of the instant claim in light of the discussion regarding claim 1 above. In particular, the "tiff format" of the copending claim is "a standardized image format" as claimed.

Referring to claims 6-9, copending claims 8-11 include all of the limitations of the instant claims respectively, in light of the discussion regarding claim 1 above.

Referring to claim 14, copending claim 12 includes all of the limitations of the instant claim in light of the discussion regarding claim 1 above.

Referring to claims 15-16, copending claims 13-14 include all of the limitations of the instant claims respectively, in light of the discussions regarding claims 1 and 3 above.

3. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,974,412 to Hazlehurst et al. in view of U.S. Patent No. 5,778,395 to Whiting et al.

Referring to claim 1, Hazlehurst discloses a data management system as claimed. See Figures 4-12 and the corresponding portions of Hazlehurst's specification for this disclosure. In particular, Hazlehurst teaches a data management system [See Fig. 4] comprising:

a first processor [slurpee 90] for restoring [See column 7, lines 31-41 & the discussion of Fig. 6] a plurality of received data files [documents from sources 62], the data files being capable of being different file types [any type of document];

a file organizing/categorizing processor [grinder 100], coupled to the first processor [See Figs. 4-5], for organizing the received data files into data slices [clusters], each data slice including an identification number [cluster centroid vector] and a descriptor [topic text description] that describes characteristics of the received data file [See column 11, line 33 et seq.];

a file logging processor [mite 106], coupled to the file organizing/categorizing processor [See Figs. 4-5], for logging the received data files into a first database [asset tank 78] based on the data slices [according to the index tank 80];

an image conversion processor [slurpee 90] for converting at least a portion of the received data files into image files [standard/canonical source-independent format];  
and

a second processor [liaison 88], coupled to the image conversion processor, for exporting the image files [to user 86].

Hazlehurst does not explicitly state that the standard format resulting from the slurpee file conversion is an image file as claimed. Furthermore, Hazlehurst does not teach "a data uploading processor, coupled to the file logging processor, for uploading the first database to a second database" or "a de-duplicate processor, coupled to the data uploading processor, for calculating a SHA value of the received data files to determine whether the received data files have duplicates and flagging duplicated data files in the second database" as claimed. However, Hazlehurst does teach the archival of some of the documents by the mites (106), as well as the removal of duplicate files by the slurpees (90). See the respective portions of Hazlehurst's specification for the

details of this disclosure. This provides suggestion for uploading (archiving) the documents to a second database, and removing duplicates from this database.

Whiting discloses a system and method similar to that of Hazlehurst, wherein documents are uploaded to a second database in an image format, and then de-duplication is performed to remove duplicates. See Figs. 1-3 and the corresponding portions of Whiting's specification for this disclosure. In particular, Whiting teaches a data uploading processor [100] for uploading [backing up] a first database [102-105] to a second database [101] and a de-duplicate processor [either client workstations or agent 108], coupled to the data uploading processor, for calculating a SHA value [hash value] of the received data files to determine whether the received data files have duplicates and flagging duplicated data files in the second database [See the Abstract, Summary, and column 15, line 57 et seq.] as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Whiting's data uploading processor and de-duplicate processor to the system and method of Hazlehurst, so as to provide a means for backing up data in Hazlehurst's system while eliminating duplicated files, as well as to use an image format as Hazlehurst's standard document format. One would have been motivated to do so because of Hazlehurst's suggestion as discussed above.

Referring to claim 2, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See Figure 4 and the corresponding portion of Hazlehurst's specification, as well as Figure 1 and the corresponding portion of Whiting's specification, for the details of this disclosure. In

particular, Hazlehurst in view of Whiting teaches the system of claim 1, as above, “wherein the first database [Hazlehurst: Asset Tank 78] is a local database [on Hazlehurst’s server system] for at least one data slice [one or more clusters], and the second database [Whiting’s Backup Storage 101] is a global database [See Whiting Fig. 1] for all logged data slices [clusters]” as claimed.

Referring to claim 3, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See the discussion regarding claim 1 above, as well as Hazlehurst’s disclosure of the slurpees (90), for the details of this disclosure.

Referring to claim 4, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. Hazlehurst (as modified by Whiting) is silent on any specific format of documents accepted by the intelligent query system. However, Hazlehurst does disclose that any type of document format can be utilized in the IQE system. See column 7, lines 17-30 of Hazlehurst’s specification for this disclosure. The examiner takes Official notice that all of the file formats listed in the claim (Microsoft Mail, Outlook, GroupWise, Lotus Notes, Word, Excel, PowerPoint, and Access) were common file formats at the time of applicants’ invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the system of Hazlehurst in view of Whiting to accept documents in these file formats. One would have been motivated to do so because of Hazlehurst’s explicit disclosure as discussed above.

Referring to claim 5, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See column 35, lines 44-51 of Whiting's specification for this disclosure. Whiting's uploading processor, as applied to Hazlehurst's system, provides the attachment viewing functionality as claimed.

Referring to claim 6, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See column 11, lines 5-30 of Hazlehurst's specification for this disclosure. Although Hazlehurst (as modified by Whiting) does not explicitly disclose the file logging processor [mite], image conversion processor [slurpee], and the second processor [liaison] as working in parallel, suggestion for such is provided in the discussion regarding learning functions in neural networks on column 11, lines 5-30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Hazlehurst's (as modified by Whiting) mites, slurpees, and liaisons as parallel processors so as to perform their respective tasks in parallel to obtain the invention as claimed. One would have been motivated to do so because of Hazlehurst's direct suggestion as above.

Referring to claim 7, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See Figures 4 and 5 and the corresponding portions of Hazlehurst's specification for this disclosure. In particular, Hazlehurst in view of Whiting discloses the system of claim 1, as above, "wherein the data files [documents] having the same file type [same source type] are converted into the image files together [each source type (62) has its own slurpee (90)]" as claimed.

Referring to claim 8, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. Again see Figures 4 and 5 and the corresponding portions of Hazlehurst's specification for this disclosure. In particular, Hazlehurst in view of Whiting discloses the system of claim 1, as above, "wherein the data management system [See Figs. 4-5] includes a plurality of image conversion processors [slurpees (A, B, etc.)], each of the image conversion processors being capable of converting the data files [documents] having the same file type [same source type] into the corresponding image files" as claimed.

Referring to claim 9, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See column 15, line 57 et seq. of Whiting's specification for this disclosure. In particular, Whiting's backup system, as applied to the system and method of Hazlehurst, identifies the file type of the data files based on the SHA value [hash value] and a file header of each of the data files as claimed.

Referring to claims 10 and 11, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See Figures 4-9 and the corresponding portions of Hazlehurst's specification for this disclosure. In particular, Hazlehurst's (as modified by Whiting) system further comprises a keyword search processor [collator 108], coupled to the file logging processor [mite 106] and image conversion processor [slurpee 90], for searching a keyword [query topic] from the received data files [for logging by the mites] or the stored image files [for return to the user by liaisons], wherein if there is a hit, the corresponding document is logged in the

asset tank (78) or exported to the user, and a data file without a hit is discarded [See column 2, lines 43-47 and column 10, lines 11-20] and not exported.

Referring to claim 12, the system and method of Hazlehurst in view of Whiting as applied to claim 1 above discloses the invention as claimed. See Figure 6 and the corresponding portion of Hazlehurst's specification for this disclosure. In particular, Hazlehurst's (as modified by Whiting) system further comprises a file status filter [screens 91 & 93] to indicate different statuses of the received data files [See column 8, line 40 et seq.] as claimed.

Referring to claim 13, the system and method of Hazlehurst in view of Whiting as applied to claim 12 above discloses the invention as claimed. Hazlehurst (as modified by Whiting) is silent on the particular statuses filtered by the screens. However, Hazlehurst does state that the screens can detect and/or remove any characteristics from the documents. The examiner takes Official notice that all of the file statuses listed in the claim (new, in-progress, done, error, corrupted, encrypted, no keyword hit, big file, large page count) were common file statuses at the time of applicants' invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the system of Hazlehurst in view of Whiting to detect these file statuses by the screens 91 and 93. One would have been motivated to do so because of Hazlehurst's explicit disclosure as discussed above.

Claim 14 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Referring to claim 15, the method of Hazlehurst in view of Whiting as applied to claim 14 above discloses the invention as claimed. In particular, Hazlehurst's (as modified by Whiting) user (86) can view the image files stored in the second database [see above] after export from the IQE system of a retrieved document.

Claim 16 is rejected on the same basis as claim 3, in light of the basis for claim 14 above. See the discussions regarding claims 1 and 3 for the details of this disclosure.

Claims 17-18 are rejected on the same basis as claims 10-11 respectively, in light of the basis for claim 14 above. See the discussions regarding claims 1, 10 and 11 for the details of this disclosure.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,289,353 to Hazlehurst; 6,389,433 to Bolosky; and U.S. Patent Application Publication No. 2003/0037022 to Adya are each considered particularly pertinent to applicants' claimed invention.

The remaining prior art of record and not relied upon is considered pertinent to applicants' disclosure and portions of applicants' claimed invention.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bdg  
July 28, 2003



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